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20280	7590	09/27/2006	EXAMINER	
MOTOROLA INC 600 NORTH US HIGHWAY 45 ROOM AS437 LIBERTYVILLE, IL 60048-5343			BAYARD, DJENANE M	
			ART UNIT	PAPER NUMBER
			2141	

DATE MAILED: 09/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/027,163

Applicant(s)

COUTS ET AL.

Examiner

Djenane M. Bayard

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to amendment filed on 6/29/06 in which claims 1-20 are pending.

Response to Arguments

2. Applicant's arguments have been fully considered but they are not persuasive. As per claims 1 and 11, Applicant argues that Manabe et al in view of Whitten fails to describe or suggest any type of configuration data that includes a plurality of classes, let alone a plurality of canned replies associated with the plurality of classes. Applicant cited support for the above argument at page 11, lines 11 through 15, of the specification: "An individual canned reply is associated with a user, and a group canned reply is associated with a group of users. An individual canned reply is sent to the associated user when an inquiry or message is received from the user. A group canned reply is sent to a particular member of the associated group when an inquiry or message is received from the member". However, Whitten clearly teaches wherein "the recipient breaks the list of senders into several categories expressing the possible interest of senders (See col. 3, lines 28-30), thus breaking the senders into group of users. Furthermore, Whitten teaches wherein "Software of the sender undertakes, as indicated by block 301, to query a potential recipient of an instant message as to the contact list categories and the related status indicators. This determines the potential recipients availability and receptivity to receiving instant messages. As indicated in the block 303 the availability of the potential recipient is sent to the inquiring sender. This availability is displayed or reported at the senders PC or other messaging device, as indicated by block 305. Future messaging action depends upon the intended recipients availability for instant messaging as indicated in the

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decision block 307. If the reply indicated availability to instant messages, the sender can make a choice to send or not to send as indicated in block 309. If the recipient is not available to instant messages, the sender learns that instant, messages are blocked as per block 311 (See page 3, lines 45-60 and figure 3), thus sending a group canned reply to a particular member of the associated group when an inquiry or message is received from the member.

Claim Rejections - 35 USC § 103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4, 6, 8, 11-13, 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6584494 to Manabe et al in view of U.S. Patent No. 6, 993564 to Whitten, II.

a. As per claim 1, Manabe et al teaches a communication support system and method for promoting smooth communication in a chat system. Furthermore, Manabe et al teaches a method for a data network system for responding to a communication message, the method comprising the steps of: receiving a communication message directed to a target device from an

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originating device (See col. 4, lines 31-32 and col. 6, lines 35-41, the detection means detects the sending of any text information from a first communication device on the network); retrieving configuration data of the target device; determining whether the target device is available for interactive communication with the originating device based on the configuration data (See col. 4, lines 32-39 and col. 6, lines 46-50, the acquisition means detects whether a second communication device correlated with the detected text information is operating and acquires from the second communication device the user status); routing the communication message to the target device if the target device is available for interactive communication with the originating device (See col. 8, lines 62-65 and figure 7); and sending the canned reply to the originating device if the target device is unavailable for interactive communication with the originating device (See col. 7, lines 42-65). Furthermore, Manabe et al teaches wherein the communication message includes an originating identification associated with the originating device and a target identification associated with the target device (See col. 3, lines 10-15 and col. 4, lines 30-40). However, Manabe et al fails to teach retrieving configuration data of the target device based on the target identification, the configuration data including a plurality of classes and a plurality of canned replies associated with the plurality of classes and identifying an originating class of the originating device from the plurality of classes and a canned reply associated with originating class based on the originating identification.

Whitten, II teaches a method of authorizing receipt of instant messages by a recipient user. Furthermore, Whitten, II teaches wherein the a potential recipient of an instant message

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prepares a list of senders whose instant messages are controlled by the potential recipient and if properly authorized will be acceptable to receipt by the recipient. The recipient breaks the list into several categories expressing the possible interests of senders as indicated by the block 203. Acceptable senders are listed in each category. Individual senders may be listed in more than one category, as indicated in block 207. Included with each category is a list of status indicators as shown in the block 205. These place restrictions in receiving instant messages from otherwise acceptable senders. For example an otherwise authorized sender may be able to send an instant message to a recipient only in an emergency or for an otherwise specified purpose. In another state, the recipient may grant absolute approval to all potential senders in a selected category. In the beginning of each active session a potential recipient, as indicated in the block 209, selects from categories and the status in each category to indicate acceptable instant messages from particular senders and for specified reasons (See col. 3, lines 22-44 and figure 2).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate the teaching of Whitten, II into the claimed invention of Manabe et al in order to allow potential recipient to specify availability to receive instant messages from a plurality of list to select or activate desired list of senders (See col. 2, lines 30-40).

b. As per claim 2, Manabe et al in view of Whitten, II teaches the claimed invention as described above. Furthermore, Manabe et al teaches wherein the interactive communication is conducted in real-time between an originating user of the originating device and the target user of the target device (See col. 6, lines 63-67)

c. As per claim 3, Manabe et al in view of Whitten, II teaches the claimed invention as described above. Furthermore, Manabe et al teaches wherein the step of determining includes the step of detecting whether an instant messaging application of the target device is active (See col. 7, lines 8-20).

d. As per claim 4, Manabe et al in view of Whitten, II teaches the claimed invention as described above. Furthermore, Manabe et al teaches configuring the canned reply by the target device before the step of receiving the communication message from the originating device (See col. 7, lines 43-45).

e. As per claim 11, Manabe et al teaches a data network system for responding to a communication message, the data network system comprising: a messaging server for communicating with a plurality of client devices, the messaging server being effective to route the communication message from an originating device to the target device (See col. 6, lines 23-26 and figure 1); to send the canned reply to the originating device if the target device is unavailable for interactive communication with the originating device (See col. 3, lines 45-60). However, Manabe et al fails to teach to receive a communication message directed to a target device from an originating device, retrieve a plurality of classes and a plurality of canned replies associated with the target device, identify an originating class of the originating device from the plurality of classes and a canned reply associated with the originating class based on the originating device.

Whitten, II teaches a method of authorizing receipt of instant messages by a recipient user. Furthermore, Whitten, II teaches wherein the a potential recipient of an instant message prepares a list of senders whose instant messages are controlled by the potential recipient and if properly authorized will be acceptable to receipt by the recipient. The recipient breaks the list into several categories expressing the possible interests of senders as indicated by the block 203. Acceptable senders are listed in each category. Individual senders may be listed in more than one category, as indicated in block 207. Included with each category is a list of status indicators as shown in the block 205. These place restrictions in receiving instant messages from otherwise acceptable senders. For example an otherwise authorized sender may be able to send an instant message to a recipient only in an emergency or for an otherwise specified purpose. In another state, the recipient may grant absolute approval to all potential senders in a selected category. In the beginning of each active session a potential recipient, as indicated in the block 209, selects from categories and the status in each category to indicate acceptable instant messages from particular senders and for specified reasons (See col. 3, lines 22-44 and figure 2, See col. 3, lines 45-60 and figure 3).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate the teaching of Whitten, II into the claimed invention of Manabe et al in order to allow potential recipient to specify availability to receive instant messages from a plurality of list to select or activate desired list of senders (See col. 2, lines 30-40).

f. As per claims 6 and 16, Manabe et al in view of Whitten, II teaches the claimed invention as described above. Furthermore, Manabe et al teaches determining whether rules for

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configuration of the originating device exist (See col. 7, lines 1-7).

g. As per claims 8 and 18, Manabe et al in view of Whitten, II teaches the claimed invention as described above. Furthermore, Manabe et al teaches determining whether rules for configuration of the target device exist (See col. 9, lines 55-64).

h. As per claim 12, Manabe et al in view of Whitten, II teaches the claimed invention as described above. Furthermore, Manabe et al teaches wherein the messaging proxy is incorporated within the messaging server (See col. 4, lines 24-29).

i. As per claim 13, Manabe et al in view of Whitten, II teaches the claimed invention as described above. Furthermore, Manabe et al teaches wherein the target device includes an instant messaging application that is active (See col. 7, lines 25-40).

5. Claims 5, 7, 9, 15, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,584,494 to Manabe et al in view of Whitten, II as applied to claim 1 and 11 above, and further in view of U.S. Patent No. 6,430, 604 to Ogle et al.

a. As per claims 5 and 15, Manabe et al in view of Whitten, II teaches the claimed invention as described above. However, Manabe et al in view of Whitten, II failed to teach wherein the step of sending the canned reply to the originating device includes the step of withholding the communication message from the target device.

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Ogle et al teaches a technique for enabling messaging systems to use alternative message delivery mechanism. Furthermore, Ogle et al teaches wherein if the test has a negative result then the message can not be sent (See col. 11, lines 4-14).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein the step of sending the canned reply to the originating device includes the step of withholding the communication message from the target device as taught by Ogle et al in the claimed invention of Manabe et al in view of Whitten, II in order to enable messages to be sent from instant messaging system to users who are reachable through alternative delivery mechanism (See col. 2, lines 46-48).

b. As per claims 7 and 17, Manabe et al in view of Whitten, II teaches the claimed invention as described above. However, Manabe et al in view of Whitten, II failed to teach the steps of routing a first canned reply to the originating device if the target device is in at least one classification of devices, and routing a second canned reply to the originating device if the target device is outside of the at least one classification of devices.

Ogle et al teaches the steps of routing a first canned reply to the originating device if the target device is in at least one classification of devices, and routing a second canned reply to the originating device if the target device is outside of the at least one classification of devices (See col. 8, lines 30-55).

I would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein the steps of routing a first canned reply to the originating device if the target device is in at least one classification of devices, and routing a second canned

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reply to the originating device if the target device is outside of the at least one classification of devices as taught by Ogle et al in the claimed invention of Manabe et al in view of Whitten, II in order to order to enable messages to be sent from instant messaging system to users who are reachable through alternative delivery mechanism (See col. 2, lines 46-48).

c. As per claims 9 and 19, Manabe et al in view of Whitten, II teaches the claimed invention as described above. However, Manabe et al in view of Whitten, II failed to teach the steps of routing a first canned reply to the originating device if a location of the target device is within a defined area, and routing a second canned reply to the originating device if the location of the target device is outside of the defined area.

Ogle et al teaches the steps of routing a first canned reply to the originating device if a location of the target device is within a defined area, and routing a second canned reply to the originating device if the location of the target device is outside of the defined area (See col. 3, lines 36-49).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate the steps of routing a first canned reply to the originating device if a location of the target device is within a defined area, and routing a second canned reply to the originating device if the location of the target device is outside of the defined area as taught by Ogle in the claimed invention of Manabe et al in view of Whitten, II in order to enable messages to be sent from instant messaging system to users who are reachable through alternative delivery mechanism (See col. 2, lines 46-48).

6. Claims 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Paten U.S. Patent No. 6,584,494 to Manabe et al in view of U.S. Patent No. 6,993564 to Whitten, II as applied to claim 1 and 11 above, and further in view U.S. Patent 6,301603 To Aravamudan et al.

a. As per claims 10 and 20, Manabe et al in view of Whitten, II teaches the claimed invention as described above. However, Manabe et al in view of Whitten, II failed to teach the step of retrieving status information of at least one of the originating device and the target device, wherein the step of determining whether the target device is available for interactive communication includes the step of comparing the status information against the configuration data to determine whether the target device is available for interactive communication.

Aravamudan et al teaches an assignable associate priorities for user-definable instant messaging buddy groups. Furthermore, Aravamudan et al teaches the step of retrieving status information of at least one of the originating device and the target device, wherein the step of determining whether the target device is available for interactive communication includes the step of comparing the status information against the configuration data to determine whether the target device is available for interactive communication (See col. 7, lines 20-65).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate the step of retrieving status information of at least one of the originating device and the target device, wherein the step of determining whether the target device is available for interactive communication includes the step of comparing the status information against the configuration data to determine whether the target device is available for interactive

communication as taught by Aravamudan et al in the claimed invention of Manabe et al in view of Whitten, II in order to provide features and capabilities associated with existing and emerging Instant messaging services and communication protocols to locate a registered user, query the user for a proposed message disposition or other action (See col. 2, lines 25-30).

7. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent U.S. Patent No. 6,584,494 to Manabe et al in view of U.S. Patent No. 6,993,564 to Whitten, II as applied to claim 1 and 11 above, and further in view of U.S. Patent Application No 2004/0048615 to Kato et al

a. As per claim 14, Manabe et al in view of Whitten, II teaches the claimed invention as described above. However, Manabe et al in view of Whitten, II failed to teach a location register coupled to at least one of either the messaging server and the messaging proxy, the location register being effective to generate a current location of the target device.

Kato et al teaches a mobile packet communication system. Furthermore, Kato et al teaches a location register coupled to at least one of either the messaging server and the messaging proxy, the location register being effective to generate a current location of the target device (See page 5, paragraph [0095]).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate a location register coupled to at least one of either the messaging server and the messaging proxy, the location register being effective to generate a current location of the target device as taught by Kato et al in the claimed invention of Manabe et al in view

Whitten, II in order to store for each mobile terminal address the current location of the corresponding mobile terminal (See page 5, paragraph [0095]).

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Djenane M. Bayard whose telephone number is (571) 272-3878. The examiner can normally be reached on Monday- Friday 5:30 AM- 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Djenane Bayard

Patent Examiner


RUPAL DHARIA
SUPERVISORY PATENT EXAMINER